

REMARKS

Claim Rejections

Claims 1-4 are rejected under 35 U.S.C. § 112, second paragraph. Claims 1-4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Olson (US-D284,024) in view of Cairns (US-4,887,324).

Drawings

Applicant proposes to amend FIG. 3 as illustrated in red on the attached photocopy. In FIG 3, it is proposed to add reference number --44--. No "new matter" has been added to the original disclosure by the amendment to this figure. Approval of the proposed drawing change is respectfully requested.

Except for the above proposed drawing corrections, it is noted that the Examiner has accepted the drawings as originally filed with this application.

Amendments to Specification

Applicant has amended the specification as noted above to provide antecedent basis for the flat connector portion (44) that was illustrated in the figures as originally filed with this application. No "new matter" has been added to the original disclosure by the foregoing amendments to the specification.

New Claims

By this Amendment, Applicant has canceled claims 1-4 and has added new claims 5-12 to this application. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The new claims are directed toward a side hook for a shower curtain (20") comprising: a base (41); a flexible plate (42) having a first surface resiliently pressing against a first surface of the base; a flat connector portion (44) connecting a first end of the base and a first end of the flexible plate, the flat connector portion extending perpendicularly from the first surface of the base; and a clamping passage (43)

located between a second end of the base and a second end of the flexible plate, wherein an edge of the shower curtain is inserted into the clamping passage and removably secured between the base and the flexible plate.

Other embodiments of the present invention include: the flexible plate is a curved flexible plate; a plurality of first teeth (421) extending from a first surface of the curved flexible plate and resiliently engaging the first surface of the base; a plurality of second teeth (412) extending from the first surface of the base and meshing with the plurality of first teeth; a double-sided adhesive tape (411) located on a second surface of the base; the flexible plate includes an arched section and at least one flat section (421'); a plurality of teeth (422') located on the at least one flat section and extending from the first surface of the flexible plate, the plurality of teeth resiliently engaging the first surface of the base, wherein the first surface of the base is flat.

The primary reference to Olson discloses a clamping strip for a shower curtain including a base, a top surface pressing against the base, and a curved portion adjoining the base and the first surface. Teeth are located on flat interior surfaces of the base and the first surface.

Olson does not teach a flat connector portion connecting a first end of the base and a first end of the flexible plate; the flat connector portion extending perpendicularly from the first surface of the base; a plurality of first teeth extending from a first surface of the curved flexible plate and resiliently engaging the first surface of the base; nor does Olson teach a plurality of teeth located on the at least one flat section and extending from the first surface of the flexible plate, the plurality of teeth resiliently engaging the first surface of the base, wherein the first surface of the base is flat.

The secondary reference to Cairns discloses a curtain retaining apparatus including first, second, and third arms (102, 108, 116). The first arm includes flanges (128, 130), each having a bead (132, 134) located on a first side, and a tape (146) located on a second side. The third arm includes a flange (140) with a bead (142) inserted between the two flanges (128, 130).

Cairns does not teach a flexible plate having a first surface resiliently pressing against a first surface of the base; the flat connector portion extending

perpendicularly from the first surface of the base; a plurality of first teeth extending from a first surface of the curved flexible plate and resiliently engaging the first surface of the base; a plurality of second teeth extending from the first surface of the base and meshing with the plurality of first teeth; the flexible plate includes an arched section and at least one flat section; nor does Cairns teach a plurality of teeth located on the at least one flat section and extending from the first surface of the flexible plate, the plurality of teeth resiliently engaging the first surface of the base, wherein the first surface of the base is flat.

Even if the teachings of Olson and Cairns were combined, as suggested by the Examiner, the resultant combination does not suggest: the flat connector portion extending perpendicularly from the first surface of the base; a plurality of first teeth extending from a first surface of the curved flexible plate and resiliently engaging the first surface of the base; nor does the combination suggest a plurality of teeth located on the at least one flat section and extending from the first surface of the flexible plate, the plurality of teeth resiliently engaging the first surface of the base, wherein the first surface of the base is flat.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring

way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Olson or Cairns that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Olson nor Cairns disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art

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to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.

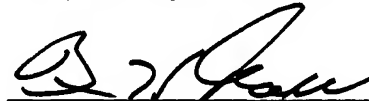
Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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